

REMARKS

Claims 1-2, 5-8, and 10-12 are pending in this application. Claims 1-2, 5-8, and 10-12 stand rejected from the final Office Action dated August 6, 2003. This paper makes no amendments to the pending claims, but does amend one paragraph of the specification as noted below.

Objection under 35 U.S.C. § 132

The Examiner objects to the amendment of the paragraph bridging pages 36-37 of April 16, 2002, as introducing new matter into the specification. Specifically, the Examiner believes that the original specification states that Bionolle #1020 contains 30% talc as purchased, while the amendment states that Bionolle #1020 has 30% talc added to it. Applicants' previous submission from the FBAW website did not persuade the Examiner as to the talc content of Bionolle #1020, considering it a general and not a specific description.

At the suggestion of the Examiner, Applicants submit the original, untranslated corresponding paragraph from the Japanese priority application number 9-366176. (See Appendix A.) Applicants also submit a translation of this paragraph, which states that Bionolle #1020 "was used as a talc-containing polybutylene succinate." (See Appendix B.) In this paper, Applicants have amended this paragraph to conform to the translation provided in Appendix B. Applicants submit that no new matter is added by this amendment because it merely conforms the English language specification to the original Japanese text. Applicants apologize for any confusion regarding this paragraph and respectfully request that this rejection be withdrawn.

Rejections over Tsai et al.

The Examiner has rejected claims 1-2, 5-6, 8, and 10-12 under 35 U.S.C. § 102(e) as anticipated by, or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,910,545 to Tsai et al. Applicants respectfully traverse these rejections.

Bionolle #1020 Talc Content. In view of the translation of the original Japanese paragraph and the conforming amendment to the specification, Applicants submit that the original paragraph is incorrect in specifying or implying that Bionolle #1020 contained talc as purchased. In fact, as Applicants have previously stated, Bionolle #1020 does not contain talc as purchased. In support of this assertion, Applicants present two additional references relating to the composition of Bionolle #1020.

First, Appendix C is a marketing brochure from the Showa Highpolymer Co., Ltd., describing the characteristics of Bionolle products. The translation of this brochure (see Appendix D) indicates that the Bionolle #1020 is one example of the 1000 series of Bionolle products, i.e., an aliphatic polyester obtained by the reaction described and represented by the general formula displayed. In particular, the 1000 Bionolle series is a polybutylene succinate (PBS). The paragraph at issue thus properly recites Bionolle #1020 as a polybutylene succinate source.

Second, Appendix E is the Material Safety Data Sheet of Bionolle 1000 series provided by Showa Highpolymer Co., Ltd. As shown in the translation (see Appendix F), the Bionolle 1000 series of products is a single product, not a mixture, and is 99% pure. The Material Data Sheet further states that the data sheet is specifically applicable to Bionolle #1020. Thus, the Material Safety Data Sheet is further evidence

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

that Bionolle #1020 does not contain 30% talc as purchased since it (1) is not a mixture and (2) is 99% polybutylene succinate.

Applicants respectfully submit that the marketing brochure and Material Safety Data Sheet constitute substantial evidence that Bionolle #1020 does not contain talc as purchased in spite of the translation of the original Japanese specification. Given the publicly available references cited, one of ordinary skill would have known that Bionolle #1020 does not contain talc as purchased and would have fully understood the specification to disclose that the Applicants added talc to Bionolle #1020 to create a "talc-containing (30%) grade of the aliphatic polyester type biodegradable resin." Therefore, Applicants submit that Bionolle #1020 does not contain talc as purchased and that the composition of Tsai et al. is not essentially the same as the claimed composition, in spite of the Examiner's assertions. As a result, Applicants respectfully submit that Tsai et al. neither anticipates nor renders obvious the claims of the instant application and request that the rejections be withdrawn.

Rule 131 Declaration. The Examiner continues to find the Rule 131 Declaration submitted with the Amendment dated June 14, 2002, unpersuasive to antedate Tsai et al. because a single invention report does not include the combination of each and every limitation recited in the pending claims. Applicants have previously argued that a single invention report need not disclose each and every claim limitation, citing MPEP § 715.07. Applicants respectfully submit that the Declaration stands by itself to assert possession of the claimed invention prior to the October 31, 1997, effective date of Tsai et al. The invention reports constitute exhibits attached as evidence of this prior possession. Thus the declaration, when considered in its entirety as mandated by Ex

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Parte Ovshinsky, 10 U.S.P.Q.2d 618 (B.P.A.I. 1950), *prima facie* demonstrates the prior possession of the claimed subject matter.

Specifically, the Declaration executed by Yoshifumi Miyajima states that on or before October 31, 1997, the named inventors had completed an invention and that the completed invention was the one described and claimed in this application. In support of this statement, attached to the Declaration are two invention reports which, taken together with the Miyajima Declaration, demonstrate that prior to October 31, 1997, the inventors did indeed complete an invention within the scope of the claims. In particular, the invention report dated September 17, 1997, records the fact that the inventors conceived of and reduced to practice fasteners within the scope of independent claim 12. The invention report dated October 31, 1997, additionally records the fact that the inventors conceived of and reduced to practice fasteners within the scope of independent claim 1. As stated in the Declaration, both of these invention reports formed the basis for the two Japanese patent applications on which this application relies for foreign priority under 35 U.S.C. § 119. Applicants therefore respectfully submit that the Declaration establishes a reduction to practice prior to October 31, 1997, of the inventions recited in the pending claims.

Moreover, Applicants respectfully submit that the Declaration shows prior invention of as much as is taught by Tsai et al. In *In re Clarke*, the court stated that:

In our view, where it can be concluded that facts, offered in a Rule 131 affidavit in support of a general allegation of conception and reduction to practice of the invention, would persuade one of ordinary skill in the art to a reasonable certainty that the applicant possessed so much of the invention as to encompass the reference disclosure, then that showing should be accepted as establishing *prima facie* a case of inventorship prior to the reference, sufficient for the purpose of overcoming the reference in an *ex parte* case.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

356 F.2d 987, 992 (C.C.P.A. 1966). Thus Applicants need only show possession of as much of their invention as is shown by Tsai et al. in order to antedate it effectively. The Examiner asserts that Tsai et al. teaches a biodegradable resin comprising of polylactic acid and a butylene succinate polymer. (See Office Action (Paper No. 7) at § 11.) The invention disclosure of September 17, 1997, shows that, at least as of that date, the inventors possessed fasteners formed of a biocomponent polymer having a dispersed phase polylactic acid and a continuous phase comprising at least one aliphatic polyester selected from the group consisting of polybutylene succinate and polyethylene adipate. Thus, Applicants submit that invention disclosure reveals that the inventors possessed as much of their invention as is shown by Tsai et al. prior to its effective date.

As a result, not only does the declaration as a whole serve to antedate Tsai et al., but the single invention disclosure of September 17, 1997, serves to antedate the reference because it demonstrates possession of as much of the claimed invention as the reference shows. Therefore, Applicants respectfully request that the Examiner withdraw the rejections based on Tsai et al. because that reference *prima facie* does not constitute prior art against the claims of this application.

Rejections over Obuchi et al.

The Examiner has rejected claims 1-2, 5-6, 8, and 10-12 under 35 U.S.C. § 102(e) as anticipated by, or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,916,950 to Obuchi et al. Applicants respectfully traverse these rejections.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

In the previous amendment dated June 11, 2003, Applicants amended claims 1 and 12 to recite a “molded article comprising an interlocking fastener component.” In response, the Examiner states that “Obuchi et al. teach that tying materials may be molded from the resin. A tying material is used for fastening and, by definition, must interlock in some form or the other in order to tie.” (Office Action (Paper No. 25) at § 9.) Applicants respectfully submit that the Examiner’s interpretation of the word “interlocking” is at odds with its plain meaning.

According to *In re Zletz*, the words of a claim must be given their plain meaning unless the Applicants have provided a clear definition in the specification. 893 F.2d 319 (Fed. Cir. 1989). Further, the claim terminology must be read as it would be interpreted by one of ordinary skill in the art. See MPEP § 2111.01. These two requirements combine to state that the claims must be given “their broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1272 (Fed. Cir. 2000). As a result, the Examiner may interpret the claim term “interlocking” broadly as long as that understanding is not contrary to its usage in the specification and by a skilled artisan.

Applicants submit that the dictionary definition of “interlocking” excludes a tying material. See *In re Morris*, 127 F.3d 1048 (Fed. Cir. 1997) (the court used a dictionary definition of the word “portion” to construe that claim term prior to issuance of the patent). According to the Merriam-Webster Online Dictionary, interlock means “to become locked together or interconnected.” Interconnected further means “to connect with one another.” (See Appendix G.) These definitions indicate that an article, to be interlocking, comprises two or more pieces that connect with one another to become locked together; they do not indicate that a unitary material would interlock. Therefore,

an "interlocking fastener," as recited by the pending claims, would comprise fastener members or elements that connect to one another and lock together. The specification clearly supports such a definition and one of ordinary skill would certainly interpret "interlocking" in this way in light of the teachings in the specification and the term's plain meaning from the dictionary.

The tying material of Obuchi et al., on the other hand, would not be understood by one of ordinary skill to encompass an interlocking fastener. The reference merely recites "tying material" in a lengthy list of possible uses for its molded articles (see col. 9, lines 13-45) without any further definition in the specification. The verb "tie," according to the Merriam-Webster Online Dictionary, means "to fasten, attach or close by means of a tie," "to form a knot or bow in," or "to make by tying constituent elements." The noun "tie" also means "a line, ribbon, or cord used for fastening, uniting, or drawing something closed; especially: shoelace." (See Appendix G.) Given these definitions, Applicants submit that one of ordinary skill, upon reading the bare recitation of "tying material" in Obuchi et al., would not understand that term to encompass an interlocking fastener. Each of the example materials, like cord, ribbon, or a shoelace, does not contain members or elements that would interlock together. While a tying material may connect together objects to which it is attached, these definitions do not indicate or suggest that the tying material itself would interlock, i.e., have pieces, members, or elements that become locked together or interconnected.

Because a "tying" material need not also be "interlocking," Applicants respectfully submit that Obuchi et al. neither anticipates nor renders obvious the pending claims. Anticipation requires that a reference, either expressly or inherently, disclose each and

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

every element of the claim. See MPEP § 2131. A *prima facie* case of obviousness requires that the reference teach or suggest each of the claim limitations. See MPEP § 2143.03. Through the arguments above, Applicants have shown that Obuchi et al. does not disclose, teach, or suggest an “interlocking fastener” as recited in the pending claims. Applicants therefore respectfully request the withdrawal of these rejections.

Rejection over Yamada et al.

The Examiner rejects claim 7 under 35 U.S.C. § 103(a) as obvious over Obuchi et al. or Tsai et al. in further view of JP 09-041220 to Yamada et al. With the Rule 131 Declaration previously submitted, Applicants have antedated Tsai et al. to remove it as a proper reference; through the arguments above, Applicants have shown the Obuchi et al. does neither anticipates nor renders obvious the pending claims because it does not disclose, teach, or suggest an “interlocking fastener component.” Applicants now submit that Yamada et al. does not remedy the deficiencies of these references and cannot by itself serve to render obvious the invention recited in claim 7. Applicants therefore respectfully request that this rejection be withdrawn.

Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-2, 5-8, and 10-12 in condition for allowance. With the amendments to the specification and remarks presented, this Amendment should allow for immediate action by the Examiner.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com